REMARKS

Claims 5-16 are pending in this application. By this Amendment, claims 5 and 14 are amended. The amendments introduce no new matter. Support for amended claims 5 and 14 can be found, for example, on page 7, lines 8 and 9 of specification. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance for the reasons discussed below; (b) do not raise any new issue requiring further search and/or consideration, as the amendments do not change the scope of the claims; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

The Office Action, on page 5, rejects claims 5-16 under 35 U.S.C. §112, second paragraph. This rejection is respectfully traversed.

The Office Action asserts that the term "instruction form" recited in the independent claims (claims 5, 8, 11 and 14) is ambiguous. Applicants respectfully disagree with this assertion.

The second paragraph of 35 U.S.C. §112 requires claims to be set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson,* 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). The test for compliance with 35 U.S.C. §112, second paragraph is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. *Miles Lab., Inc. v. Shandon Inc.,* 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), *cert. denied,* 510 U.S. 1100 (1994). If the claims, <u>read in light of the specification</u>, reasonably apprise those skilled in the

art of the scope of the invention, Section 112 demands no more. *See, also, In re Merat,* 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975) (stating that the question under Section 112, second paragraph is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct), *In re Warmerdam,* 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

One of ordinary skill in the art would readily understand the claim term "instruction form" when read in the context of each of the independent claims. For example, each of the independent claims recites an instruction form that indicates a process to be executed to a document. Moreover, the meaning of this term is clear when read in light of the specification. For example, page 6, line 11 through page 7, line 5, of the specification describes the claim term "instruction form" with sufficient precision. For at least these reasons, one of ordinary skill in the art would readily understand the term "instruction form" recited in each of the independent claims and thus, contrary to the Office Action's assertion, the term is not ambiguous. As such, the rejection of claims 5-16 under §35 U.S.C. §112, second paragraph is unreasonable. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

The Office Action, on page 5, rejects claims 5-16 under 35 U.S.C. §101 as being directed to nonstatutory subject matter. This rejection is respectfully traversed.

The Office Action notes that claims 5 recites "an instruction form management apparatus," and "a storage that stores an instruction form." The Office Action then asserts that the claimed features link to no hardware entities. Applicants respectfully disagree. Claim 5 recites structural elements. For example, claim 5 recites an apparatus that includes a storage part; an output part; and a deletion part.

The Office Action, on page 6, asserts that claims 8-10 recite an instruction form management system without connecting to a hardware element. The Office Action also notes that claim 8 recites connected via a network. The Office Action then asserts that the term in network implicitly covers a general entity of an environment, where this environment is not necessary as a cluster of computers. The Office Action concludes that "system" remains covering the software *per se*. The Office Action's analysis fails for the following reasons.

Claims 8-10, and in particular claim 8, recites a system that is defined by structural elements, contrary to the Office Action's assertions that claim 8 does not recite hardware elements. For example, claim 8 recites at least one instruction form execution apparatus and an instruction form management apparatus; instruction form management apparatus comprises a generation part, and an output part; the at least one instruction form execution apparatus comprises an instruction form reception part, an execution part, and a deletion part. Each of these parts is a structural element, not a software element. Applicants also submit that the term a network is a structural element, contrary to the Office Action's assertions. Moreover, regarding the claim features, if there is a manner by which the structural element can be interpreted as valid, the Examiner must interpret them as valid. The Examiner cannot impute a meaning to claimed structural elements in a manner that are per se invalid. For at least these reasons, claims 8-10 are statutory, as they recite valid structural elements.

The Office Action, on page 6, also asserts that claims 11-16 clearly cover software per se because the claimed features do not link to hardware elements. Claims 11-16 recite a system that includes multiple apparatuses. For the reasons discussed above with respect to claims 8-10, these claims also recite statutory subject matter as defined under § 101.

Accordingly, for these reasons, reconsideration and withdrawal of the § 101 rejection of claims 5-16 are respectfully requested.

The Office Action, on page 6, rejects claims 5-16 under 35 U.S.C. §102(b) over Oracle9i case studies-XML applications, 2001 (hereinafter "Oracle"). This rejection is respectfully traversed.

Independent claim 5 recites, among other features, a storage part that stores an instruction form that indicates a process to be executed to a document by at least one of a plurality of instruction form execution apparatuses connected to the instruction form management apparatus via a network. Oracle cannot reasonably be considered to teach, or to have suggested, these features.

Oracle merely teaches a system that allows a user to fill in an order form which is then output to a supplier after the user clicks on "Place Order" (see, e.g., Fig. 8-5). This "form" does not correspond to "an instruction form" as recited in the pending claims, and as discussed above. Oracle further teaches that once the order form is output to the supplier, the data that was entered into the form is deleted (see, e.g., Fig. 8-5). Oracle does not teach, nor does it suggest that the order form includes information related to a process to be executed to a document by at least one of a plurality of instruction form execution apparatuses connected to the instruction form management apparatus via a network. As such, Oracle cannot reasonably be considered to teach, or to have suggested, the above-recited feature of claim 5. Thus, Oracle cannot reasonably be considered to teach, or to have suggested, the combination of all of the features positively recited in claim 5. Further, claims 6 and 7 also would not have been suggested by Oracle for at least the respective dependence of these claims directly or indirectly on claim 5, as well as for the additional features each of these claims recites.

Independent claims 8 and 11 recite, among other features, a generation part that generates an instruction form that indicates a process to be executed to a document by the at least one instruction form execution apparatus. Independent claim 14 recites, among other features, a storage part that stores an instruction form that indicates a process to be executed
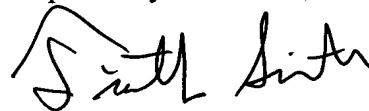
to a document by the at least one instruction form execution apparatus. For the reasons discussed above with respect to claim 5, Oracle cannot reasonably be considered to teach, or to have suggested, these features recited in each of these claims. Further, claims 9, 10, 12, 13, 15 and 16 would not have been suggested by Oracle for at least the respective dependence of these claims directly or indirectly on allowable base claims, as well as for the additional features each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection of claim 5-16 under 35 U.S.C. §102(b) are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 5-16 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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